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| APPLICATION NO.                      | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------|-------------|------------------------|---------------------|------------------|
| 10/601,074                           | 06/20/2003  | Richard Henry Williams | DYOUNG0219USA       | 8873             |
| 7590 11/17/2004                      |             |                        | EXAMINER            |                  |
| Neil A. DuChes                       |             |                        | SAYALA, CHHAYA D    |                  |
| Renner, Otto, Biosselle & Sklar, LLP |             |                        | ART UNIT            |                  |
| 1621 Euclid Avenue, Nineteenth Floor |             |                        | PAPER NUMBER        |                  |
| Cleveland, OH 44115                  |             |                        | 1761                |                  |

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/601,074

Applicant(s)

WILLIAMS ET AL.

Examiner

C. SAYALA

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 27, last line, spelling of "fatty" needs correction and "terpene" is a repetition.

2. Claims 31-32 provide for the use of the fertilizer composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 31-32 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 3163001.

The abstract teaches sodium, potassium and ammonium phosphate together with thiosulfate. The composition is applied as an aqueous solution. The terms “fertilizer composition” address the use of this composition, and it is well established that a new use for an old composition is patentable.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-6, 7, 10, 13-15, 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 3163001 in view of JP 06183903.

JP 3163001 teaches a preserving agent for cut flowers that uses thiosulfate as a quality retaining agent and a sodium/ammonium/potassium phosphate as a stabilizing agent. The abstract does not show the remaining ingredients.

JP '903 teaches water soluble solid acids such as organic acids (citric, oxalic etc.), amino acids such as glutamic acid; carbohydrate as a nutrient, such as glucose, fructose etc; fungicide such as thiosulfate; plant growth regulator such as cytokinin; growth inhibitors such as chlormequat and benzoic acid as pH regulator. The patent teaches "carbonate" as an adjuvant. This composition is also useful for preservation of cut flowers. Because both compositions are useful for preservation of cut flowers, it would have been obvious to one of ordinary skill in the art to combine two compositions useful for the same purpose. It is prima facie obvious to combine two compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the same purpose; the idea of using them flows logically from their having been individually taught in prior art. In re Kerkhoven, 205 USPQ 1069 (CCPA 1980). In addition, each ingredient has been shown by these references to fulfill a definite purpose and usefulness in the composition.

5. Claims 1-18, 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over over Taylor (US Patents 5800837 and 5736164) in view of GB 2259912, DD 133512 and Chen et al (US Patent 5341932).

Taylor '837 teaches a fertilizer composition comprising phosphates that are useful to stimulate plant growth. Taylor ('164) teaches a fungicidal composition for plants comprising phosphites. At col. 2, lines 10-30 ('837), Taylor teaches that it was known in prior art (Thizy et al) at the time the invention was made that phosphate was used as fungicide and fertilizer. The phosphite was supplied as a potassium or sodium

salt in an aqueous solution, such as monosodium or monopotassium phosphite together with surfactants such as those claimed at instant claim 27. The thiosulfate is not shown.

GB 2259912 teaches ammonium thiosulfate as a plant growth stimulator also (see page 1, line 1). Note claim 8, which shows amounts to be used. At page 1, lines 29-31, teaches that the thiosulfate can be used in conjunction with fungicides or plant growth regulators. It would have been obvious to use thiosulfate with phosphite salts, which Taylor shows as a fungicide.

DD 133512 teaches agents for improving water utilization by plants that comprise acetylsalicylate and a phosphonate. The specification at page 4, lines 25+, admits of knowledge that was available in prior art that relates to salicylic acid, homologues etc. in its use as agrochemicals. At page 3, lines 15-17, the specification admits of prior art that describe the use of organic acids as buffers to achieve stable solutions when phosphorus containing fertilizer solutions are used. At page 10, lines 20 plus the specification notes that conventional ingredients suitable for a fertilizer composition are organic acids, sucrose, carbon sources, potassium salts, and at page 11, phosphorus salts, amino acids, vitamins, fatty acids, nitrogen sources and sulfur.

The Chen et al reference lists agrochemicals that were known in the art at the time the invention was made. For example, chloromequat, alkanolamines, benzenediazo sulfonate (sulfonates – instant claim 27).

It would have been obvious to combine these conventional ingredients and agrochemicals with the phosphite and thiosulfate taught as fungicides and fertilizers by the primary references because such combinations are common in the prior art, each

Art Unit: 1761

for its own purpose and usefulness. To determine amounts of phosphonate based in the amounts of thiosulfate disclosed by the GB patent would have been within the ambit of routine skill.

6. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (US Patents 5800837 and 5736164) in view of GB 2259912 and Okamoto et al. (US Patent 4397678).

The primary references are as discussed above. They do not disclose cytokinin as plant growth regulators. The GB patent teaches that thiosulfate can be used in conjunction with plant growth regulators. Okamoto et al. teach cytokinin type compounds as plant growth regulators. It would have been obvious to use this in conjunction with the fungicides of the primary references since thiosulfate, has been taught as being used with a plant growth regulator and cytokinin is such a compound.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1-14, 29-30 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12, 15-16, 20-21 of prior U.S. Patent No. 6770593. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 26, 28, 31-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13, 17-19 of U.S. Patent No. 6770593. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of these claims are the same with variations in recitation and language only.

9. Claims 15-25, 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6770593 in view of admitted prior art at pages 10-11 of the specification and Thizy et al. (US Patents 4075324 and 4119724) and Okamoto et al.



The claims of the issued patent do not teach the subject matter of the above instant claims. However, the specification admits that these are conventional ingredients in fertilizer compositions: nutrients, vitamins, vitamins, sugar, amino acids, and sulfonates. Thizy et al. teach phosphites as fungicides. Okamoto et al. teach that thiosulfate can be used in conjunction with plant growth regulators such as the cytokinin type compounds of Okamoto et al., it would have been obvious to combine them with phosphite and thiosulfate, which is also shown by prior art to be a growth regulator.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA whose telephone number is 571-272-1405.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/601,074  
Art Unit: 1761

Page 9

  
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